



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/748,197

12/31/2003

Chang-Seob Kim

66249/L550

6732

23363 7590 06/01/2011
CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER

LAIOS, MARIA J

ART UNIT

PAPER NUMBER

1727

MAIL DATE

DELIVERY MODE

06/01/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Art Unit: 1727

Applicant argues that the cited references do not appear to disclose or suggest at least the first electrode being disposed at substantially the center of the battery unit on an innermost layer of the battery unit.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, Narukawa discloses that "the incised portion may be provided in any portion of the positive-electrode plate" while Vourlis depicts the electrode tab can be placed in the substantially center of the battery unit overlap and faces the second electrode tab (Figure 9) or at the outer periphery portion (Figure 10) (col. 8 lines 35-65). Therefore it would have been obvious to place the electrode tabs of the battery unit of Narukawa in a location where, upon wind up of the jelly roll unit, the tabs partially overlap each other because it has been held that rearranging parts of an invention involves only routine skill in the art (*In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)). See MPEP 2144.04 (VI). Also, it has been held that "disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments" (MPEP 2123) and that "a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use" (MPEP 2123).

Furthermore, In response to applicant's argument that the reference does not disclose the tab is substantially the center of the battery unit on the innermost layer of the battery unit, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).